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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,479	06/01/2000	Alexander C. Schmidt	15280-414000US	8296

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EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,479

Applicant(s)

SCHMIDT ET AL.

Examiner

Stacy B. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 85,88-92,94-96,98,99,101,104,107,108,113-117,119,122-126,128-130,132,133,135,140,141,146-152,154,157,159,162 and 163.

Continuation of Disposition of Claims: Claims rejected are 85,88-92,94-96,98,99,101,104,107,108,113-117,119,122-126,128-130,132,133,135,140,141,146-152,154,157,159,162 and 163.

DETAILED ACTION

1. Applicant's amendment filed March 16, 2006 is acknowledged and entered. Claims 85, 88-92, 94-96, 98, 99, 101, 104, 107, 108, 113-117, 119, 122-126, 128-130, 132, 133, 135, 140, 141, 146-152, 154, 157, 159, 162 and 163 are pending and under examination. Because of the new rejection set forth below, this Office action is made non-final. Any inconvenience to Applicant is regretted.

Claim Objections

2. The objection to claims 153-157 for misspelling the term, "infectious", is withdrawn in view of Applicant's amendment.

(New Objection) Claims 119, 122-126, 128-130, 132, 133, 135, 140, 141, 122, 146-152, 159, 162 and 164 are objected to. Claim 119 and all dependent claims recite, "An isolated polynucleotide comprising polynucleotide encoding", which should be corrected to, "An isolated polynucleotide comprising a polynucleotide encoding".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(New Rejection) Claims 85, 88-92, 94-96, 98, 99, 101, 104, 107, 108, 113-117, 119, 122-126, 128-130, 132, 133, 135, 140, 141, 146-152, 154, 157, 159, 162 and 163 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 85 recites the limitation "said partial or complete PIV vector genome or antigenome" in claim 85. There is insufficient antecedent basis for this limitation in the claim because claim 85 does not refer to a "vector" genome prior to the recitation of "said partial or complete PIV vector genome". Consistent terminology is required throughout the claims.

Claim 152 recite, "a polynucleotide of any one of claims 199-122", however, claims 120 and 121 have been cancelled. The metes and bounds of the claims cannot be determined. Correction is required.

Claim Rejections - 35 USC § 102

4. The rejection of claims 84, 85, 87, 89-96, 99-104, 117, 118, 119, 121, 123-130, 133-137 and 150-152 under 35 U.S.C. 102(e) as being anticipated by Belshe *et al* (5,869,036), is moot with respect to cancelled claims, and withdrawn to pending claims in view of Applicant's persuasive arguments.

With regard to the claims that recite, "said partial or complete PIV genome or antigenome comprising a polynucleotide encoding a wild-type L protein of the PIV", the limitation distinguishes the claims from Belshe. Applicant argues, and the examiner agrees that Example 5 is directed to a complementation assay, wherein the L gene (among others) was introduced into a plasmid. CV-1 cells were co-transfected with the plasmid vector pRSV-T and one or more recombinant plasmids, such as the L gene. Twenty-four hours post-transfection, the expressing cells were infected with cp45 virus. Based on this complementation assay, Belshe concludes that cp45 viruses complemented with the wild-type L protein, produced by the cell, are capable of replicating at the non-permissive temperature for the cp45 virus (col. 16, lines 54-

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62). The wild-type L gene is not incorporated into the genome (as required by the claims).

Therefore, Belshe does not teach or suggest the invention as claimed.

Double Patenting

5. Claims 85, 88-92, 94-96, 98, 99, 101, 104, 107, 108, 113-117, 119, 122-126, 128-130, 132, 133, 135, 140, 141, 146-152, 154, 157, 159, 162 and 163 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 144-215 of copending Application No. 09/083,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application is encompasses the embodiments set forth in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 85, 88-92, 94-96, 98, 99, 101, 104, 107, 108, 113-117, 119, 122-126, 128-130, 132, 133, 135, 140, 141, 146-152, 154, 157, 159, 162 and 163 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 53-85 of copending Application No. 09/458,813. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application is encompasses the embodiments set forth in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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7. Claims 85, 88-92, 94-96, 98, 99, 101, 104, 107, 108, 113-117, 119, 122-126, 128-130, 132, 133, 135, 140, 141, 146-152, 154, 157, 159, 162 and 163 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 and 46-74 of copending Application No. 09/459,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application encompasses the embodiments set forth in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 85, 88-92, 94-96, 98, 99, 101, 104, 107, 108, 113-117, 119, 122-126, 128-130, 132, 133, 135, 140, 141, 146-152, 154, 157, 159, 162 and 163 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 180-222 of copending Application No. 09/733,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application is a species of the instantly claimed genus of PIVs, rendering the genus claims obvious. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. No claim is allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Stacy B. Chen 4/18/06

Stacy B. Chen
Primary Examiner
April 18, 2006